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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,076	01/16/2002	Dan Kikinis	P1553D2	3459

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/052,076

Applicant(s)

KIKINIS, DAN

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,18,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,18,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide enablement for a code sent from the user computer to instruct a server to transmit emails directly to the portable device. The specification supports "a code is sent to the host server 120 indicating now the subscriber is in the field" on page 7, lines 28-29.

Specification

3. The amendment filed January 3, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "to send information updates directly to the playback device via a wireless transmission facility 122" and "thereby directing the emails to the playback device 110 via PC 123".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo, USPN 6,370,546 B1 (hereafter referred to as Kondo) in view of Oberlander et al., USPN 5,825,865 (hereafter referred to as Oberlander)

6. Regarding claim 16, Kondo taught a system for delivering emails to a user (abstract), comprising:

a network-connected server for receiving and processing the emails (email service connected to networks, column 12, lines 22-28);

a wireless transmission facility in communication with the network-connected server, for transmitting the emails (base station 21, column 12, lines 22-28); and

a portable playback device enabled for connection to a user computer and receiving the emails transmitted by a transmission facility and to display the emails as text to the user (portable personal computer 1, column 10, lines 4-6);

wherein the server transmits emails to the user computer for download to the portable playback device while the device connected to the user computer (column 12, lines 49-59), and upon disconnection of the portable device from the user computer a

server transmits the emails directly to the portable device via the wireless transmission facility (column 5, lines 63-67; column 6, lines 1-11).

Kondo does not specifically teach a database at the network server for storing user preferences used by the network-connected server for processing the emails and a code instructs the server to transmit the emails directly to the portable device via the wireless transmission facility. However, Oberlander taught a database at network connected server for storing user preferences used by network-connected server for processing the emails and a code instructs the server to transmit the emails directly to the portable device via the wireless transmission facility (column 9, lines 42-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Oberlander's preferences and code in Kondo's system for downloading emails to a coupled computer system would have improved effectiveness. The motivation would have been to allow receiving parties to have better control over the reception of incoming messages.

7. Regarding dependent claim 18, Kondo taught wherein the network is Internet network (column 1, lines 18-22).

8. Regarding claim 19, taught a method for delivering multimedia emails to a user, comprising the steps of:

a) receiving the multimedia emails on a network by a network-connected server (originator send emails to recipients, column 12, lines 22-28);

d) transmitting individual ones of the emails over the network by the network-connected server (transmitting emails to recipient associated with portable computer 1, column 12, lines 22-28);

e) receiving the transmitted emails at a user computer for download to a portable playback device connected to the user computer, displaying the emails on a display of the playback device (portable personal computer 1, column 10, lines 4-6); and

wherein the network-connected server transmits emails to the user computer for download to the portable device via the network while the device is connected to the user computer (column 12, lines 49-59), and upon disconnection of the portable device from the user computer a server transmits the emails directly to the portable device by a wireless transmission facility (column 5, lines 63-67; column 6, lines 1-11). Kondo does not specifically teach preferences and a code. However, Oberlander taught b) storing user preferences at a database at a network-connected server (column 5, lines 16-25); c) processing the emails at the network-connected server by accessing the user preferences (column 8, lines 17-29); f) editing the user preferences via direct communication from the playback device (column 9, lines 42-54); and a code instructs the server to transmit the emails directly to the portable device via the wireless transmission facility (column 9, lines 42-54). For motivation see claim 16, above.

9. Regarding dependent claim 21, Kondo taught wherein the network is the Internet (column 1, lines 18-22).

Response to Arguments

10. Applicant's arguments with respect to claims 16, 18-19, 21 have been considered but are moot in view of the new ground(s) of rejection.

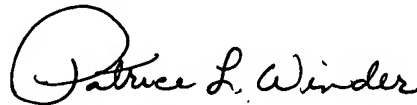
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Patrice L. Winder". The signature is fluid and cursive, with a large initial "P" and "W".

Patrice Winder
Primary Examiner
Art Unit 2145

March 5, 2007